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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,394	01/24/2000	Gerhard P. Weber	P04359USO-PHI-1248	7097

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EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/190,394

Applicant(s)

Weber

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

- 3 -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

12-27-01

- ☒ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-32 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-4, 9, 20, 22 is/are allowed.
- ☒ Claim(s) 5-8, 10-19, 21, 23-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The amendment of 27 December 2001 and accompanying arguments have overcome all outstanding rejections. Applicant's statement regarding the conditions of the deposit in the amendment of 27 December 2001 has overcome the rejection under 35 USC 112, first paragraph.

Claims 5-8, 10-19, 21 and 23-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite in its recitation in line 3 of "the tissue" which lacks antecedent basis. Insertion of "--culture--" after "tissue" in line 3 would obviate this rejection. Dependent claims 6-7 are included in the rejection.

Claim 6 is indefinite in its recitation of "the...protoplasts" which lacks antecedent basis in claim 5. The following amendment would obviate this rejection:

In line 1, delete "the" before "cells" and insert "--of the tissue culture--" after "protoplasts".

Claims 12, 25 and 29, and dependent claims 13-15, 26-28, and 30-32, are indefinite in their recitation of "plant according to claim 2 [or 20] contains...transgenes [or genes transferred by backcrossing]". Since the claims are initially drawn to plants with defined characteristics and genotypes (such as claim 2) which exclude the presence of transgenes or backcrossed genes, it is confusing to further characterize these plants as containing additional genes. Replacement of "contains" with "--further comprises--" would obviate this rejection.

Claims 11, 15, 19, 24, 28 and 32 are indefinite in their recitation of "superior", "above average", and "particularly suited" as these terms are unduly narrative and imprecise, and do not

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clearly set forth the degree of expression of the claimed characteristics or clearly characterize the corn plants exhibiting them.

Claims 10, 14, 18, 23, 27 and 31, and dependents, are indefinite in their recitation of "[t]he maize plant breeding program of claim 9 [or 13 or 17 or 22 or 26 or 30]", which is confusing, since the previous claims are drawn to methods rather than breeding programs. Amendment of claims 10, 14, 18, 23, 27 and 31 to replace "maize plant breeding program" with --method-- would obviate this rejection.

Claims 8 and 21 are indefinite for characterizing the male fertile plant of claim 2 [or claim 20] as male sterile. The following amendment would obviate this rejection:

Replace "wherein said maize plant is male sterile" with --further comprising a genetic factor conferring male sterility--.

Claims 12, 16, 25 and 29, and dependent claims 13-15, 17-19, 26-28 and 30-32, are indefinite in their recitation of "hybrid maize plant according to claim 2 [or 20]" which lacks antecedent basis. Amendment of claims 12, 16, 25 and 29 to delete "hybrid" would obviate this rejection.

The indication in the last office action that claims 11, 15, 19, 24, 28 and 32 were free of the prior art is hereby WITHDRAWN in view of the following newly discovered reference. The delay in prosecution is regretted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 15, 19, 24, 28 and 32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan (U.S. Patent 5,824,848 filed February 1997 and issued October 1998).

The claims are drawn to maize plants which exhibit at least two traits exhibited by hybrid 39W54, including "superior yield potential" and "particularly suited to the Northwest, Northcentral, and Northeast regions of the United States", and which have 39W54 in their pedigree. The claims do not specify the number of generations of crossing or whether 39W54 was used in more than one cross.

Morgan teaches Dent maize plants with dark green leaves, green glume, pink anther, pendant ear, curved row direction, and yellow endosperm, wherein said plants show excellent yield and were developed in Iowa (see, e.g., columns 11-12, Tables 1 and 2; column 12, lines 58-67; and columns 13-14, Table 3). The plants taught by Morgan differ from the claimed plants only in the use of 39W54 as a parent. However, the mere use of 39W54 as a parent at some point

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in the breeding history would not confer a unique characteristic to the resultant plants which would distinguish them from the prior art plants, given the loss of 39W54 genetic material with each generation of crossing and with each outcross to a non-39W54 parent, and given the existence of other maize genetic material which would confer the claimed traits. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art, given the failure of the prior art to teach or suggest the particularly claimed maize plants with their unique complement of genotypic and morphological characteristics, or methods of using them.

Claims 1-4, 9, 20 and 22 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 25, 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638

